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| Applicants: | Farzad Hiri, <i>et al.</i> | § | Group Art Unit: | 2645 |
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| Serial No: | 09/643,621 | § | Examiner: | MD S Elahee |
| | | § | | |
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For: Methods of Controlling Communications With at Least Two Calling Party Devices
by a User of a Called Party Device

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APPEAL UNDER 35 U.S.C. §134

This Brief is submitted to appeal the decision of the Primary Examiner set forth in a Final Official Action dated December 2, 2005, finally rejecting all pending claims.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §41.20(b)(2) that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1379.

Real Party in Interest

The real party in interest, by assignment, is: Telefonaktiebolaget LM Ericsson (publ)
SE-164 83
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Related Appeals and Interferences

None.

Status of Claims

Claims 1-7, 9-19 and 21-35 are presently pending in the application, each of which are finally rejected and form the basis for this Appeal. Claims 1-4, 6, 7, 9, 10, 13-16, 18, 19, 21, 22, 32 and 33 stand rejected, under 35 U.S.C. §103(a), as being unpatentable over Gregorek, *et al.* (US 5,557,658); claims 5, 17 and 29 stand rejected over Gregorek in view of Casellini (US 6,404,860) further in view of Rogers, *et al.* (US 5,946,386); claims 11, 23 and 34 stand rejected over Gregorek in view of Casellini further in view of Tatchell, *et al.* (US 6,160,877); and claims 12, 24 and 35 stand rejected as being unpatentable over Gregorek in view of Casellini further in view of Tatchell and further in view of Zhakov, *et al.* (US 2003/0021264). Claims 1-7, 9-19 and 21-35, including all amendments to the claims, are included in the Claims Appendix. The rejection of claims 1-7, 9-19 and 21-35 is appealed.

Status of Amendments

The claims set out in the Claims Appendix include all entered amendments. No amendment has been filed subsequent to the final rejection.

Summary of Claimed Subject Matter

Claim 1

| Claim Element | Specification Reference |
|--|--|
| 1. A method of controlling communications with at least two calling party devices by a user of a called party device, said method comprising the steps of: | Page 7, line 7, <i>et seq.</i> |
| establishing a first call link between said called party device and a first calling party device; | Figure 1-A; page 7, line 7, <i>et seq.</i> ; page 8, line 4, <i>et seq.</i> |
| receiving a call request to said called party device from a second calling party device; | Figure 1-B; page 7, line 10, <i>et seq.</i> ; page 9, line 1, <i>et seq.</i> |
| placing said first call link on hold; | Figure 1-B; page 9, line 14, <i>et seq.</i> |
| accepting said call request from said | Figure 1-B; page 10, line 4, <i>et seq.</i> |

| | |
|--|---|
| second calling party device to establish a second call link between said called party device and said second calling party device; | |
| causing, through the selective activation by said user of said called party device, a message to be transmitted to said first calling party device, said step of causing a message to be transmitted to said first calling party device comprising the step of said user selecting one of a plurality of predefined messages using an input mechanism associated with said called party device while said called party device is in communication with said second calling party device, whereby said user of said called party device can communicate information to a user of said first calling party device without interrupting communications with a user of said second calling party device. | Page 11, line 1, <i>et seq.</i> Figure 1-C, page 11, line 22, <i>et seq.</i> Figure 1-D, page 13, line 16, <i>et seq.</i> Figure 1-E, page 15, line 14, <i>et seq.</i> |

Claim 13

| Claim Element | Specification Reference |
|--|---|
| 13. A communications device for receiving and controlling communications with at least two calling party devices by a user thereof, said communications device comprising: | Page 7, line 7, <i>et seq.</i> |
| means for establishing a first call link between said communications device and a first calling party device; | Figure 1-A; page 7, line 7, <i>et seq.</i> ; page 8, line 4, <i>et seq.</i> |
| means for receiving a call request to said communications device from a second calling party device; | Figure 1-B; page 7, line 10, <i>et seq.</i> ; page 9, line 1, <i>et seq.</i> |
| means for placing said first call link on hold; | Figure 1-B; page 9, line 14, <i>et seq.</i> |
| means for accepting said call request from said second calling party device to establish a second call link between said communications device and said second calling party device; | Figure 1-B; page 10, line 4, <i>et seq.</i> |
| means for causing, through the selective activation by said user of said called party device, a message to be transmitted to said first calling party device, said means for causing a message to be transmitted to said first calling party device comprising means for | Page 11, line 1, <i>et seq.</i> Figure 1-C, page 11, line 22, <i>et seq.</i> Figure 1-D, page 13, line 16, <i>et seq.</i> Figure 1-E, page 15, line 14, <i>et seq.</i> |

said user of said communications device to select one of a plurality of predefined messages using an input mechanism associated with said communications device while said communications device is in communication with said second calling party device, whereby said user of said communications device can communicate information to a user of said first calling party device without interrupting communications with a user of said second calling party device.

Claim 25

| Claim Element | Specification Reference |
|---|---|
| 25. A method of controlling communications with at least two remote telephony devices by a user of a telephony device, said method comprising the steps of: | Page 7, line 7, <i>et seq.</i> |
| establishing a first call link between a first remote telephony device and said telephony device; | Figure 1-A; page 7, line 7, <i>et seq.</i> ; page 8, line 4, <i>et seq.</i> |
| establishing a second call link between a second remote telephony device and said telephony device; and, | Figure 1-B; page 10, line 4, <i>et seq.</i> |
| while said first call link is on hold and said telephony device is in communication with said second remote telephony device, causing, through the selective activation by said user of said telephony device, a message to be transmitted to said first remote telephony device, said step of causing a message to be transmitted to said remote telephony device comprising the step of said user selecting one of a plurality of predefined messages using an input mechanism associated with said telephony device while said telephony device is in communication with said second remote telephony device, whereby said user of said telephony device can communicate information to a user of said first remote telephony device without interrupting communications with a user of said second remote telephony device. | Page 11, line 1, <i>et seq.</i> Figure 1-C, page 11, line 22, <i>et seq.</i> Figure 1-D, page 13, line 16, <i>et seq.</i> Figure 1-E, page 15, line 14, <i>et seq.</i> |

The specification references listed above are provided solely to comply with the USPTO's current regulations regarding appeal briefs. The use of such references should not be interpreted to limit the scope of the claims to such references, nor to limit the scope of the claimed invention in any manner.

Grounds of Rejection to be Reviewed on Appeal

1.) Claims 1-4, 6, 7, 9 10, 13-16, 18, 19 21, 22, 32 and 33, stand rejected, under 35 U.S.C. §103(a), as being allegedly unpatentable over Gregorek *et al.* (US 5,557,658 hereinafter Gregorek), claims 5, 17 and 29 allegedly over Gregorek in view of Casellini (US 6,404,860 hereinafter Casellini) further in view of Rogers *et al.* (US 5,946,386 hereinafter Rogers), claims 11, 23 and 34 allegedly over Gregorek in view of Casellini further in view of Tatchell *et al.* (US 6,160,877 hereinafter Tatchell) and claims 12, 24 and 35 allegedly over Gregorek in view of Casellini further in view of Tatchell and further in view of Zhakov *et al.* (US 2003/0021264 hereinafter Zhakov).

Argument

1.) Claim Rejections – 35 U.S.C. §103(a)

In previous rejections, the Examiner rejected each of Applicants' independent claims as being anticipated by Gregorek. In accepting Applicants' response to the prior Office Action, the Examiner apparently recognized the deficiency of Gregorek in anticipating those claims. To overcome the deficiencies of Gregorek, the Examiner now looks to the teachings of Casellini. The teachings of Casellini in combination with Gregorek, however, also fail to teach the claimed invention.

Claim 1 recites:

1. A method of controlling communications with at least two calling party devices by a user of a called party device, said method comprising the steps of:
 - establishing a first call link between said called party device and a first calling party device;
 - receiving a call request to said called party device from a second calling party device;
 - placing said first call link on hold;

accepting said call request from said second calling party device to establish a second call link between said called party device and said second calling party device;

causing, through the selective activation by said user of said called party device, a message to be transmitted to said first calling party device, said step of causing a message to be transmitted to said first calling party device comprising the step of **said user selecting one of a plurality of predefined messages** using an input mechanism associated with said called party device **while said called party device is in communication with said second calling party device**, whereby said user of said called party device can communicate information to a user of said first calling party device without interrupting communications with a user of said second calling party device. (emphasis added)

The Applicants' invention is characterized by a user of a called party device causing a message to be transmitted to said first calling party device **by selecting one of a plurality of predefined messages** using an input mechanism associated with said called party device **while said called party device is in communication with said second calling party device**.

Gregorek discloses a call processing system which can transmit a generally continuous pre-recorded announcement to a telephony device that has been placed on hold. **Unlike the Applicants' invention**, however, the transmission of the pre-recorded announcement is under the automatic control of a switch 22 or attached network signaling system (ANSS) 23, rather than the **user** of a called party device. The Examiner fails to point to any teaching in Gregorek where a **user** of a called party device causes the sending of a message to a first calling party device **using an input mechanism associated with said called party device**.

Furthermore, and most importantly, claim 1 recites that the step of causing a message to be transmitted to a first calling party device **(while on hold)** includes the step of the user (of the called party device) selecting one of a plurality of predefined messages (using an input mechanism associated with said called party device) **while the called party device is in communication with a second calling party device**. Gregorek simply does not disclose the ability of a user of a telephony device, **while a first calling party is on hold and such device is in communication with a second calling party**, to select one of a plurality of predefined messages and cause it to be transmitted to the first calling party, whereby the user of the called party device can

communicate information to a user of the first calling party device without interrupting communications with a user of the second calling party device.

The Examiner states (page 5, 2nd paragraph, of the Final Office Action) that Gregorek teaches:

“the step of causing an announcement to the first calling party device comprising one of a plurality of customized announcements [i.e., predefined messages] using an input mechanism associated with the called party device while the called party is in communication with the second calling party.” (emphasis added)

That assertion by the Examiner as to what Gregorek teaches, however, appears to contradict his later statement (page 5, 3th paragraph) that Gregorek “does not specifically teach ‘the step of causing an announcement to the first calling party device comprising the step of the user selecting one of a plurality of predefined messages’.” (emphasis added) Regardless of the Examiner's apparently contradictory statements, it is apparent that neither Gregorek or Casellini disclose the step of causing a message to be transmitted to a **first** calling party device (**while on hold**), including the step of the user (of the called party device) selecting one of a plurality of predefined messages (using an input mechanism associated with said called party device) **while the called party device is in communication with a second calling party device**. The Examiner, again, ignores these limitations of claim 1 and points to no teaching in Gregorek or Casellini to support his rejection.

Furthermore, the Examiner points to no teaching or suggestion in Gregorek or Casellini to combine their teachings to arrive at the claimed invention. Moreover, **Casellini actually teaches away from the claimed invention**. The teachings of Casellini are directed to a Call Management Application that is separate from a user's device on which calls are received; the call management application is internet-based, while a user actually receives calls on a separate telephony device. According to Casellini, a user has a telephone or other communication device, such as a mobile wireless handset (200). (see column 1, lines 41-43) If a user doesn't answer a call to their telephony device (analogous to Applicants' claimed “called party device”), then the call is redirected to a call management application that the user can access via their separate internet-connected computer. (see column 1, 45-51). It is to improvements in

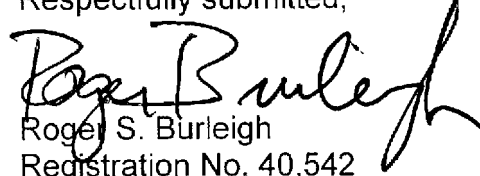
such call management application that the teachings of Casellini are directed. In contrast, as recited in Applicants' claim 1, **a user's called party device is used both to establish call links with different first and second callers**, but also to cause, through the selective activation by a user of the called party device, a message to be transmitted to a first calling party device, the step of causing a message to be transmitted to the first calling party device comprising the step of the user selecting one of a plurality of predefined messages **using an input mechanism associated with the called party device** while the called party device is in communication with the second calling party device, whereby a user of the called party device can communicate information to a user of the first calling party device without interrupting communications with a user of the second calling party device. **Casellini teaches away from the use of a common device for both call connections and simultaneous messaging to calling parties in the manner claimed by Applicants.** Accordingly, Casellini fails to overcome the deficiencies of Gregorek, and claim 1 is not obvious in view of those references.

Independent claims 13 and 25 recite limitations analogous to those of claim 1 and, therefore, those claims are also not obvious over Gregorek in view of Casellini. Furthermore, whereas claims 2-7 and 9-12 are dependent from claim 1, claims 14-19 and 21-24 are dependent from claim 13, and claims 26-35 are dependent from claim 25, and include the limitations of their respective base claims, those claims are also not obvious over Gregorek in view of Casellini, or in further view of Rogers, Tatchell, or Zhakov. The Applicants, therefore, respectfully request that the Board reverse the Examiner's rejection of claims 1-7, 9-19 and 21-35 as being obvious.

CONCLUSION

In view of the foregoing, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner's rejection thereof be reversed and the application be remanded for further prosecution.

Respectfully submitted,



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APPENDIX

Pending Claims

1. (Previously Presented) A method of controlling communications with at least two calling party devices by a user of a called party device, said method comprising the steps of:

establishing a first call link between said called party device and a first calling party device;

receiving a call request to said called party device from a second calling party device;

placing said first call link on hold;

accepting said call request from said second calling party device to establish a second call link between said called party device and said second calling party device;

causing, through the selective activation by said user of said called party device, a message to be transmitted to said first calling party device, said step of causing a message to be transmitted to said first calling party device comprising the step of said user selecting one of a plurality of predefined messages using an input mechanism associated with said called party device while said called party device is in communication with said second calling party device, whereby said user of said called party device can communicate information to a user of said first calling party device without interrupting communications with a user of said second calling party device.

2. (Original) The method recited in Claim 1, wherein said message instructs said user of said first calling party device to hold.

3. (Original) The method recited in Claim 1, wherein said message instructs said user of said first calling party device that said call link to said called party device will be disconnected.

4. (Original) The method recited in Claim 3, further comprising the step of automatically causing said first call link to be terminated.

5. (Original) The method recited in Claim 1, wherein said message instructs said user of said first calling party device to leave a message.

6. (Original) The method recited in Claim 4, further comprising the step of automatically causing said first calling party device to be connected to a messaging system associated with said user of said called party device.

7. (Original) The method recited in Claim 1, wherein said message comprises a prerecorded voice message.

8. (Cancelled)

9. (Original) The method recited in Claim 1, wherein said step of causing a message to be transmitted to said first calling party device comprises the step of said user generating a text message using an input mechanism associated with said called party device.

10. (Original) The method recited in Claim 9, further comprising the step of converting said text message to speech.

11. (Original) The method recited in Claim 1, wherein said call links between said called party device and said calling party devices are established through a packet-switched communications network.

12. (Original) The method recited in Claim 11 wherein said call links are established using an Internet Engineering Task Force (IETF) Session Initiation Protocol (SIP).

13. (Previously Presented) A communications device for receiving and controlling communications with at least two calling party devices by a user thereof, said communications device comprising:

means for establishing a first call link between said communications device and a first calling party device;

means for receiving a call request to said communications device from a second calling party device;

means for placing said first call link on hold;

means for accepting said call request from said second calling party device to establish a second call link between said communications device and said second calling party device;

means for causing, through the selective activation by said user of said called party device, a message to be transmitted to said first calling party device, said means for causing a message to be transmitted to said first calling party device comprising means for said user of said communications device to select one of a plurality of predefined messages using an input mechanism associated with said communications device while said communications device is in communication with said second calling party device, whereby said user of said communications device can communicate information to a user of said first calling party device without interrupting communications with a user of said second calling party device.

14. (Original) The communications device recited in Claim 13 wherein said message instructs said user of said first calling party device to hold.

15. (Original) The communications device recited in Claim 13 wherein said message instructs said user of said first calling party device that said call link to said communications device will be disconnected.

16. (Original) The communications device recited in Claim 15 further comprising means for automatically causing said first call link to be terminated.

17. (Original) The communications device recited in Claim 13 wherein said message instructs said user of said first calling party device to leave a message.

18. (Original) The communications device recited in Claim 17 further comprising means for automatically causing said first calling party device to be connected to a messaging system associated with said user of said communications device.

19. (Original) The communications device recited in Claim 13, wherein said message comprises a prerecorded voice message.

20. (Cancelled)

21. (Original) The communications device recited in Claim 13, wherein said means for causing a message to be transmitted to said first calling party device comprises means for said user of said communications device to generate a text message using an input mechanism associated with said communications device.

22. (Original) The communications device recited in Claim 21, further comprising means for converting said text message to speech.

23. (Original) The communications device recited in Claim 13, wherein said call links between said communications device and said calling party devices are established through a packet-switched communications network.

24. (Previously Presented) The communications device recited in Claim 23, wherein said call links are established using an Internet Engineering Task Force (IETF) Session Initiation Protocol (SIP).

25. (Previously Presented) A method of controlling communications with at least two remote telephony devices by a user of a telephony device, said method comprising the steps of:

establishing a first call link between a first remote telephony device and said telephony device;

establishing a second call link between a second remote telephony device and said telephony device; and,

while said first call link is on hold and said telephony device is in communication with said second remote telephony device, causing, through the selective activation by said user of said telephony device, a message to be transmitted to said first remote telephony device, said step of causing a message to be transmitted to said remote telephony device comprising the step of said user selecting one of a plurality of predefined messages using an input mechanism associated with said telephony device while said telephony device is in communication with said second remote telephony device, whereby said user of said telephony device can communicate information to a user of said first remote telephony device without interrupting communications with a user of said second remote telephony device.

26. (Previously Presented) The method recited in Claim 25, wherein said message instructs said user of said first remote telephony device to hold.

27. (Previously Presented) The method recited in Claim 25, wherein said message instructs said user of said first remote telephony device that said call link to said telephony device will be disconnected.

28. (Previously Presented) The method recited in Claim 27, further comprising the step of automatically causing said first call link to be terminated.

29. (Previously Presented) The method recited in Claim 25, wherein said message instructs said user of said first remote telephony device to leave a message.

30. (Previously Presented) The method recited in Claim 28, further comprising the step of automatically causing said first remote telephony device to be connected to a messaging system associated with said user of said telephony device.

31. (Previously Presented) The method recited in Claim 25, wherein said message comprises a prerecorded voice message.

32. (Previously Presented) The method recited in Claim 25, wherein said step of causing a message to be transmitted to said first remote telephony device comprises the step of said user generating a text message using an input mechanism associated with said telephony device.

33. (Previously Presented) The method recited in Claim 32, further comprising the step of converting said text message to speech.

34. (Previously Presented) The method recited in Claim 25, wherein said call links between said telephony device and said remote telephony devices are established through a packet-switched communications network.

35. (Previously Presented) The method recited in Claim 34, wherein said call links are established using an Internet Engineering Task Force (IETF) Session Initiation Protocol (SIP).

* * *

APPENDIX

Evidence Appendix

None.

APPENDIX

Related Proceedings Appendix

None.